

**REMARKS**

Claims 1-39 are pending in this application. Claims 1, 4, 6, 7, 8, 12, 16, 20-24, 28, 32, and 36-39 are independent claims. Claims 2, 3, 5, 9-11, 13-15, 17-19, 25-27, 29-31, and 33-35 are dependent claims. Claims 1-7 have been allowed. Claims 8-39 have been rejected.

**Request for Return of Form PTO-1449**

On January 28, 2003, Applicants filed an Information Disclosure Statement (IDS) with a Form PTO-1449. A copy of this form was returned to the applicant with the May 16, 2003 Office Action. However, the Seki et al. reference (reference AM) had been marked through and not initialed. Applicants note that an English language abstract was attached to this reference. Accordingly, it is requested that the Examiner confirm consideration of this reference by initialing the block next to reference AM and returning the 1449 form. For the Examiner's convenience, copies of the IDS, the 1449 form, the Seki et al. reference (which includes the English language translation of the abstract), and the stamped postcard are attached to this response.

**Rejections Under 35 U.S.C. §251**

In item 3 on pages 2 and 3 of the Office Action, the Examiner rejected claims 8-39 under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter. Applicants respectfully traverse this rejection for the following reasons.

If a reissue claim is as broad or broader in an aspect pertaining to a prior art rejection, but narrower in another aspect unrelated to the rejection, then the recapture rule may bar the claim. However, the recapture rule may be overcome if the claim is "materially narrower" in other overlooked aspects of the invention. Claim elements are materially narrower if they were not present in the original claims, or if these elements were not pointed out in arguments attempting to overcome a rejection during the original prosecution. See Hester Industries v. Stein, Inc., 142 F.3d 1472, 1482-83 (Fed. Cir. 1998).

The Examiner stated that the features of "software management means for decoding encrypted software data and for managing monetary charges according to the usage of the

software data” were argued as being distinguishing features in the Amendment filed December 8, 1997 in the parent application, and therefore constitute improper recapture.

The Examiner raised a similar rejection in the Office Action mailed February 8, 2001. Similar to the arguments presented in the Amendment filed June 8, 2001, the features of a converter or an information converting means converting the digital information into at least one of visible and audible data have been added to independent reissue claims 8, 12, 16, 20-24, 28, 32, and 36-39. These features materially narrow the scope of the reissue claims by converting digital information received into at least one of visible and audible data for presentation to a user. Further, these features were not present in the original claims, and were not pointed out in arguments attempting to overcome a rejection during the original prosecution. Therefore, the recapture rule has been overcome.

Therefore, Applicants respectfully request withdrawal of the rejections under §251.

#### **The Oath/Declaration**

In items 5 and 6 on page 3 of the Office Action, the Examiner rejected claims 1-23 under 35 U.S.C. §251 as being based upon a defective reissue declaration. The Examiner repeated the improper recapture rejection regarding “input switchover” and “output switchover” that was raised in the February 8, 2001 Office Action. We note that the Examiner withdrew this rejection in numbered paragraph 6 on page 3 of the July 31, 2001 Office Action.

Applicants will submit a supplemental declaration upon allowance of the rejected claims.

#### **Conclusion**

In accordance with the foregoing, it is respectfully submitted that all outstanding rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding rejections, the application is submitted to be in condition for allowance, which action is earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/654,929

Docket No. 1046.1100RE

Finally, if there are any additional fees associated with filing of this response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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